## REMARKS/ARGUMENTS

In response to the Office Action mailed January 27, 2005, and the decision of the Board of Patent Appeals and Interferences dated September 29, 2006 Applicant files this Request for Continued Examination, accompanied by a Petition for Revival of an Application for Patent Abandoned Unintentionally under 37 CFR 1.137(b).

I. PRIOR ART MATTERS

A. The Office Action rejected claims 1-22 under 35 USC 103(a) as being unpatentable over Ichbiah in view of Goldwasser. Applicant respectfully traverses the rejection.

The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness.[1] If the Examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of non-obviousness.[2]

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.[3]

Applicant respectfully traverses the § 103 rejection because the Office Action has not established a *prima facie* case of obviousness.

The references do not teach or suggest all the claim limitations.

Specifically as to amended claim 1, neither reference discloses the step:

> c) actively selecting a word in the pre-existing text to be converted to an abbreviation and converting the selected word

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[1] MPEP Sec. 2141.

[2] Id.

[3] Id. (emphasis supplied)

to a corresponding abbreviation using the first data structure,
and replacing the word with the corresponding abbreviation;

Goldwasser does not teach "actively selecting" a word in the text to be converted to an abbreviation and replacing the word with the corresponding abbreviation. Rather, Goldwasser discloses a method of teaching a computer user the abbreviations of words, phrases, and command sequences to remind the user of the existence of the abbreviation whenever the user neglects to use it. Col. 2 lines 40-44. The flowcharts of the Goldwasser patent (Figs. 6A-9C) disclose that the Goldwasser invention generally operates as follows: the user enters a keystroke; the invention concatenates the keystroke to previous keystrokes in a buffer; the invention tests for a delimiter (step 112); if a delimiter is found, the system compares the characters in the buffer to a stored sequence (step 114); then an associated pointer is used to find a corresponding abbreviation (step 116) which is then demonstrated to the user by highlighting the characters of the abbreviation, beeping, or pronouncing characters (step 118). The user does not "actively select" a word in the text in this disclosed method of operation. The American Heritage Dictionary, Second College definition defines "select" as follows:

To choose from among several; pick out; to make a choice or selection.

The drawings of Goldwasser (Figs. 1-5) show that the user is merely making data entry at a single point beyond previously existing text, not actively selecting a word in the previously existing text to be converted. In other words, the user does not choose from among several previously existing words or pick out a word from the previously existing text to be converted to an abbreviation. The only word that can be converted by Goldwasser is the single word that the user is currently entering.

Furthermore, Goldwasser does not disclose replacing the word with the corresponding abbreviation. The abbreviation is merely (in some embodiments) displayed as text in addition to the corresponding word. For example, Fig. 1 shows the user entering the word "SAVE" and the computer program displaying the characters "F4" after the word "SAVE." This process is described in Goldwasser at Col. 4 lines 28-36.

Ichbiah does not disclose:

(d) actively selecting an abbreviation in the pre-existing text to
be converted to a word and converting the abbreviation to a
word using the second data structure

Ichbiah is simply a data entry method. As an abbreviation is typed, it is converted to a word or phrase. However, there is no disclosure in Ichbiah of the user going to pre-existing text and actively selecting an abbreviation to be converted to a word.

Claim 1 is therefore allowable.

Claims 2-14 contain additional elements or limitations beyond allowable claim 1 and are also allowable.

Regarding claims 3-6, Ichbiah does not select a word in the pre-existing text to be converted to an abbreviation using a keyboard or a mouse. Col. 3 lines 63-65 only teaches displaying a list of words that have already been converted from abbreviations to the user for selection, in the event that more than one word corresponds to a given abbreviation. Ichbiah only converts abbreviations to words, not vice-versa, and therefore does not teach converting words to abbreviations. As already indicated above, Goldwasser does not disclose actively selecting a word in the pre-existing text to be converted to an abbreviation, converting the word to an abbreviation using the second data structure, and replacing the word in the pre-existing text with the abbreviation. Because claims 3-6 are dependent upon claim 1, they each incorporate all limitations of claim 1. Therefore, all limitations of claims 3-6 are not disclosed by the combination of Ichbiah and Goldwasser.

Further as to claim 7, the references do not disclose a step of scanning the pre-existing text for words to be converted to abbreviations, converting words selected by the data processing method to corresponding abbreviations using the first data structure, and replacing the words in the pre-existing text with the corresponding abbreviations. Goldwasser only examines the current word being input, not text that has previously been entered. It does not replace words with abbreviations.

Regarding claim 13, Goldwasser does not disclose:

the user selecting an abbreviation from the first data structure
and inserting the abbreviation into the pre-existing text at a
position selected by the user at any position in the pre-existing
text.

Again, Goldwasser is simply a data entry system that only examines the word being entered. It does not teach the capability of inserting an abbreviation in previously entered text at any position in the previously entered text.

Regarding claim 15, the references do not show the steps:

> b) the user instructing the data processing method to select a position anywhere in the pre-existing text for insertion of an abbreviation.

> e) inserting the selected abbreviation at the selected position in the pre-existing text.

Again, Goldwasser is simply a data entry system that only examines the word being entered. It does not teach the capability of inserting an abbreviation in previously entered text at any position in the previously entered text.

The Office Action rejects claims 17 and 22 under the same rationale as method claims 1, 9-10, and 13. Since claims 1, 9-10, and 13 have been shown to be allowable, and the Office Action has not interposed any additional basis for disallowing claims 17 and 22, amended claims 17 and 22 are allowable.

The Office Action rejects claims 18-22 under the same rationale as method claims 7-8, 11-12. Since claims 7-8 and 11-12 have been shown to be allowable, and the Office Action has not interposed any additional basis for disallowing claims 18-22, claims 18-22 are allowable.

The above amendments are supported by the originally-filed disclosure and do not introduce new matter. See, e.g., Fig. 5 "REPLACE" and steps 500 and 600 (check entire text).

For the above reasons, Applicant respectfully requests the allowance of all claims and the issuance of a Notice of Allowance.

Respectfully submitted,

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